

Art Unit: 1632

DETAILED ACTION

The preliminary amendment dated 01/31/2006 has been received. Claims 6,9,14-17,19-20,23-40 are cancelled. Claims 41-46 are added. Claims 1-5,7,8,10-13,18,21-22 and 41-46 are pending.

Applicant's election of Group I, claims 1-5,7,8,41 and 42 in the reply filed on 09/12/2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

Changes to the oath are initialed but are not dated.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5,7,8,41 and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 3 are unclear for several reasons. First, the preambles read "A screening method to obtain". However, the method fails to result in obtaining a substance but rather appears to result in identifying a property of a substance. Second, the "determining effect" step fails to set forth any active

Art Unit: 1632

methodology such as a comparison step such that it would be clear that an ‘effect’ had occurred” Thus, it appears essential method steps are missing. Third, the metes and bounds of the term “biological activity” are not clear. It is not clear what would fall within the definition of “biological” activity. Claim 2 depends from claim 1. Claims 41 and 42 depend from claim 3. Similarly, claim requires that the substance be ‘obtained’.

Claims 7,8,41 and 42 are unclear because it is not clear at which method step the obtained substance is to be formulated with at least one additional component. It is not know if this step is added at the end of the method or if such a formulation is to me made prior to testing the substance on a test fish.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1) Claims 1,4-5,7-8 rejected under 35 U.S.C. 102(b) as being anticipated by Zhdanova et al (2001, Brain Research, 903:263-268).

Zhdanova taught administering via the medium melatonin, diazepam or pentobarbital to larval zebrafish 7-14 days old. Behavioral effects were observed. Zhdanova meets the limitations of determining the effect of a test substance known to cross the BBB (melatonin, diazepam or pentobarbital) on and activity of the central nervous system wherein the test substance is known to penetrate the BBB and the method is performed on zebrafish of any age.

Claim 4 is broad in that it lacks narrowing active method steps. The “method” of claim 4 requires a screening assay requiring administration of a substance whereby a substance with an activity is

Art Unit: 1632

obtained. The assays is recited to be designed based on a algorithm. An algorithm is stated in claim 1 and the art meets this limitation as set forth above. The art meets the limitations of claims 7 and 8 because addition of the substance to the culture medium of the larva meets the limitation of an additional component and carrier. Furthermore, melatonin and luzindale were dissolved in ethanol. Pentobarbital and flumazenil were dissolved in water.

2) Claims 1,4-5,7-8 rejected under 35 U.S.C. 102(b) as being anticipated by Lieberoth et al (2003, Brain Research, 903:263-268).

Lieberoth taught direct administration of rhodamine dextran amine (RDA) to a lesion in the spinal cord of adult fish and retrograde labeling of neurons in the CNS. Effects of the substance were determined by visualizing the tracer. RDA is known to not to cross the BBB and the method was performed on zebrafish of at least 5 and at least 8 and at least 10 days of age and comprises direct delivery to bypass the BBB.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Valarie Bertoglio whose telephone number is (571) 272-0725. The examiner can normally be reached on Mon-Thurs 5:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras can be reached on (571) 272-4517. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1632

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Valarie Bertoglio, Ph.D./
Primary Examiner
Art Unit 1632